



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,467	04/13/2004	Diane B. Gowaty		4608
7590	10/01/2004		EXAMINER	
Diane B. Gowaty 1017 Franklin Ct. Jefferson Hills, PA 15025			SANTOS, ROBERT G	
		ART UNIT	PAPER NUMBER	3673

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

4C

Office Action Summary	Application No.	Applicant(s)	
	10/823,467	GOWATY, DIANE B.	
	Examiner	Art Unit	
	Robert G. Santos	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 April 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: In line 2, the term cotton should be inserted before --cover--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 2 are rendered indefinite since the use of trademarks such as Velcro® is prohibited in claim language. (In this case, a phrase such as "hook and loop fastener, such as that sold under the Trademark of Velcro" should be used.)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

-
4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,822,817 to Carew et al. in view of Gershman. Carew et al. are considered to disclose all of the claimed limitations as recited in claims 1 and 2 except for the specific dimensions as recited in claim 1 as well as a cover secured in place by a hook and loop fastener.

Art Unit: 3673

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the support cushion of Carew et al. from Applicant's claimed dimensions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Moreover, Gershman teaches the use of Velcro® fasteners which are used to replace zippers. The skilled artisan would have also found it obvious at the time the invention was made to replace the zipper fastener disclosed in Carew et al. '817 with a hook and loop fastener since these fastening means have long been known in the art as functional equivalents as taught by Gershman.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Parikh '230, Davis '525, Carew et al. '998 and Carew et al. '465.

APPLICANT'S RESPONSE

The remainder of this Office Action consists of general information for the Applicant's benefit. Please see the enclosed copies of Title 37 of the Code of Federal Regulations, Sections 1.111-1.121 for details concerning the examination process and the requirements for the Applicant's response. Sections 1.118-1.121 deal specifically with the subject of amendments to the specification and claims.

Unless the Office explicitly requests the return of a paper, all papers mailed to the Applicant are intended to be kept by the Applicant for his own records.

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

The following pages were taken from a mini-lecture which was prepared for the Inventor's Expo in Baltimore in 1980.

The lecture has been included in this office action in order that the applicant may better appreciate what a patent is and what it means when an examiner rejects claims or objects to matters of form or substance in a patent application.

MINI-LECTURE FOR INVENTORS

Firstly, a patent is a grant from the Government which gives the inventor or patent holder the right to exclude others from making, using or selling whatever is CLAIMED in the patent.

I. CLAIMS

The CLAIMS are the heart and soul of a patent. A good claim may be worth money. A bad claim is always worthless.

To be entitled to a patent an applicant's invention AS CLAIMED must be:

1. different from the prior art (35 USC 102)
2. unobvious over the prior art (35 USC 103) and,
3. adequately disclosed and claimed (35 USC 112).

Claims are written as a single sentence which is the object of a sentence starting with "I (or We) claim". To see how this works look at the following three claims: I claim:

1. A vehicle having a front and a rear with a seat facing the front and four wheels including a front pair of wheels, and a back pair of wheels.
2. A vehicle having a front and a rear with a seat facing the front and four wheels including a front pair of wheels, and a back pair of wheels, and further including an engine supported primarily above said rear wheels.
3. A vehicle having a front and a rear with a seat facing the front and four wheels including a front pair of wheels and a back pair of wheels, said vehicle further including an engine supported primarily by said rear wheels, and a power train extending from said engine to said front wheels whereby said rearwardly supported engine can provide motive power to said front wheels.

These claims are of progressively narrower scope. Claims 2 and 3 could have been written in dependent form as follows:

2. A vehicle as in claim 1 and further including an engine supported primarily above said rear wheels.

3. A vehicle as in claim 2 and further including a power train extending from said engine to said front wheels whereby said rearwardly supported engine can provide motive power to said front wheels.

Claim 1 if granted would permit the patent holder to exclude others in the United States from making cars, trucks, and even wagons having a seat and four wheels.

Both claims 1 and 2 are not patentable under 35 USC 102 because the VW Bug, which has both four wheels and an engine in the rear, was known and used in this country more than one year prior to today's date in this hypothetical example.

If we assume that the VW Bug and a 1974 Cadillac having a front supported engine and rear wheel drive comprise all of the prior art, then insofar as a rejection of these claim 3 is concerned, 35 USC 102 does not apply, but 35 USC 103 may apply.

To determine the patentability of claim 3 one must answer the question: Given a front engine car with rear wheel drive and a rear engine car with rear wheel drive, would it have been obvious to provide a rear engine car with front wheel drive?

The answer to this question is not always clear. One must consider the skill of a person having ordinary competence in the car building industry. What factors would cause one of ordinary skill to make this combination, and what new and unobvious benefits are to be derived from this unique combination of features?

To define a patentable invention the prospective inventor-claim writer must add enough limitations to his claims to define something which is both different from what is in the prior art and unobvious over the prior art.

Claim 3 if granted would give the inventor the right to exclude others from making or using rear engine cars with front wheel drive, and rear engine cars with four wheel drive.

The applicant, as a general rule, does not wish to burden his claims with frivolous or unnecessary limitations. Claim 3 is valuable only if someone wants to make a rear engine car with front wheel drive and is willing to pay the patent holder money for the privilege of making such a car.

One would not, for example, wish to put in his claim the limitation that the wheels are made of chrome plated steel, because car manufacturers would be able to make the inventor's car with steel wheels were instead painted with out infringing the claim, and the chances are they would do just that to avoid paying the patent holder royalties.

In the general scheme of things the patent examiner occupies a position of quasi-prosecuting attorney and judge. As prosecuting attorney he is required to check the applicant's disclosure, to read the claims, to search out the best prior art, and to make all pertinent objections and rejections to the application which are within reason.

It is the examiner's responsibility to ensure that the applications which he handles comply with all laws passed by Congress (Title 35 of the United States Code), all regulations set forth by the Commissioner of Patents (37 Code of Federal Regulations), and all required procedures (Manual of Patent Examining Procedures).

On occasion the examiner may be able to help the applicant by writing allowable claims,
but first it must be clear to the examiner that there is an allowable concept or idea in the applicant's disclosure, and the time an examiner can spend on each application is severely limited.

In his role as a judge, the examiner is required to listen to the arguments for patentability presented by the applicant, and in taking these arguments into consideration, he is required to render what he considers to be a fair and impartial decision.

Listed above are three criteria for patentability: 1.) Novelty (102); 2.) Non-obviousness (103); and, 3.) Adequate disclosure (112). To this list the inventor-applicant should add one more criterion: money. Does the invention represent a sellable idea?

This question should be asked at every phase of development because getting a patent is not cheap and making money from a patented idea is not easy. The inventor will of course ask this question before he files his application. Also having filed an application and received a rejection from the Patent Office, the applicant must then ask the same question from a more realistic point of view. That is he or she should take a long hard look at the art cited by the examiner, the invention as disclosed, and the differences between the cited art and the disclosed invention, and the inventor must then ask himself, "Do these differences represent a sellable invention?". If the answer is again "yes", the next question to ask is "How do I get these differences into a claim which will protect my invention and which the examiner will allow?"

People not familiar with claim writing should look at the claims of patents which were cited by the examiner and try to get some feel for writing single sentence claims.

In writing a claim always think in generic terminology. For example, use terms like "fastening means" not "nail or screw" whenever possible. If an inventor's claim calls for a screw holding two parts together a competing manufacturer can make the claimed device using a nail instead to hold the parts together without infringing the claim and thus without paying the inventor or patent owner royalties. Also, since the claim must define something different and

unobvious over the prior art, claiming something like a specific fastening means will usually not help overcome an obviousness rejection because it is obvious to substitute a screw for a nail.

II. Interview In the quest to draft a claim which the examiner will allow, the most powerful option open to the inventor is the interview. If an inventor receives an action on his application which is in any way unfavorable he may ask for an interview. Interviews may be conducted either in person or over the phone.

Inventors wishing to conduct an interview must first call and arrange for an agreeable time. The examiner will want to pull the inventor's application and review the claims and prior art before discussing the application. Inventors having specific claims or changes which they wish to discuss during the interview should ask the examiner if it would be helpful to FAX a copy of the proposed changes to the office prior to the interview. The Art Unit FAX number appears at the end of the office action and proposed claims should be sent with a cover sheet having the serial number of the application, the art unit of the examiner handling the application, the examiner's name, and the notation **THIS MATERIAL IS FOR INTERVIEW PURPOSES ONLY DO NOT ENTER IN THE FILE.**

Most examiners are courteous and helpful but there are two factors which inventors should keep in mind. First the examiner's main concern is whether or not the claims are allowable. The examiner does not know if the claims which he helps to write are worth any money. Second the examiner's time is limited by an "expectancy" or a certain number of hours per disposal. This means that from the time he first receives an application for preparation of a first action until the time that the application goes to issue or abandonment the examiner must

spend a total no more than the "expected" number of hours working on the application. If the examiner spends more than the allocated time he must borrow time from other inventor's applications or work on his own time. Because of these constraints, it is normal for Examiners to limit interviews to a fixed amount of time, usually $\frac{1}{2}$ hour.

Inventors should try to make the most of the interview period by being well prepared. After the inventor has looked at the prior art he should draft what he thinks are valuable and allowable claims, and have a copy of these proposed claims for himself and for the examiner. Also, the inventor should have a list of questions or problems ready, a fairly thorough understanding of the prior art cited by the examiner and a good idea of the issues he wants to discuss.

The Patent Office does not encourage inventors to prosecute their own patent applications because the value of a patent depends firstly on the value of the idea and secondly on the skill of the person writing the claims. Examiners are not trained claim writers. Their job is first and foremost to determine the patentability of claims presented to them, and it is the job of the patent attorney and the patent owner to worry about whether or not the claims granted to the inventor were the broadest and most valuable claims he was entitled to receive under the law.

III. Correspondence Correspondence with the Patent and Trademark Office should have as part of the first page the applicant's name, the Art unit to which the application has been assigned, the serial number of the application, and name of the Patent Examiner to whom the application has been assigned. This is important to prevent papers from being lost. Also, it is called to applicant's attention that if a communication is mailed before the response time has

expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows.

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on [date]."

Name of applicant, assignee, or Registered Representative

Signature_____

Date_____

IV. How to respond to this Office Action - Applicant's Response

A. Applicant's Response

The following consists of general information for the Applicant's benefit. Unless the Office explicitly requests the return of a paper, all papers mailed to the Applicant are intended to be kept by the Applicant for his own records. The response must be signed by ALL applicants.

1. Amendments to the Specification

Any amendments to the specification must be presented as a list of additions and deletions, referring to the passages in question by page and line numbers. No new matter may be entered.

It is not necessary to submit a new specification unless one has been required by the Examiner. An example of an amendment to the specification should appear as follows:

On page 16, line 12, change "effect" to -- affect --.

Art Unit: 3673

On page 23, line 4, insert -- bucket -- after "backhoe".

(Note: the inserted language is placed between double dashes.)

2. Amendments to the Claims

The amendments to the claims should be presented in the above format. If an amendment to a claim requires the addition of more than five words, the claim should be completely rewritten with the additions to the claim being underlined. Any deletions from the claims should be enclosed in brackets. No matter may be inserted into the claims that was not in the originally filed disclosure.

As an example, if a claim for a chair were originally written as follows:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

1. (Amended) A chair comprising a horizontal seat, a vertical back, and [a plurality of] four vertical [support members] legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

If the specification or drawings originally described the inclusion of four legs on the chair, the new limitation of "four legs" in the claim would not constitute new matter.

3. Arguments

If an Office Action contains a rejection or objection to the claims, the Applicant MUST respond with arguments under the heading "Remarks", pointing out disagreements with the

Art Unit: 3673

Examiner's contentions. The Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or patentably distinguish from them. The applicant must respond to every ground of rejection and objection set forth in the Office Action. For more details of the amendment process, the Applicant can refer to 37 Code of Federal Regulations Sections 1.118 - 1.121.

B. New Matter

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. "New matter" constitutes any material which meets the following criteria:

1. It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application; and,
2. It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

C. Period for Response

The three month shortened statutory period specified in the cover letter (form PTO-326) is the period of time in which the Applicant has to respond to every rejection and objection within this Office Action. The Applicant's response must be received within three months of the date listed on the cover letter, or the application will be held abandoned.

This period, however, may be extended up to a maximum of six months, with the payment of the appropriate fee. The following table lists the required fee for extensions of the three month period:

<i>No. Months after</i>	<i>Amount</i>
<i>Office Action Date</i>	<i>of Fee</i>

Art Unit: 3673

0 - 1	-
1 - 2	-
2 - 3	-
3 - 4	\$ 55
4 - 5	\$210
5 - 6	\$475

For example, if the response is filed four months and one day after the mailing date of the Office Action, the response must be accompanied by a fee in the amount of \$190. The response must also contain a statement requesting "an extension of the period for response under 37 CFR 1.136(a)".

Applicant is hereby cautioned that the above listing of fees may have changed since the mailing of this Office Action. Applicant is advised to confirm the correct amount by calling PTO's Public Service Center at (703) 308-HELP.

D. Certificate of Mailing

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. This "Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231" on (date).

(signature)

This "Certificate" may appear anywhere on the page, and may be handwritten or typed. It MUST be signed by the person who actually deposits the paper with the Postal Service, and the date MUST be the actual date on which it is mailed.

For the purpose of calculating extensions of time, the date shown on the certificate will be used as the date on which the paper was received by the Office, regardless of the date the Postal Service actually delivers the response. In this way, postal delays would not affect the extension-of-time fee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert G. Santos whose telephone number is (703) 308-7469. The examiner can normally be reached on Tues-Fr and first Mondays, 10:30 a.m. to 8:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert G. Santos
Primary Examiner
Art Unit 3673

R.S.
September 27, 2004